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09/910,092

REMARKS

STATUS SUMMARY

Claims 1–20 are pending in the present application. The Examiner has rejected claims 1, 2, 4-15, and 17-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,402,441 to *Washizu et al.* (“*Washizu*”), and claims 3 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Washizu* in view of U.S. Patent No. 5,504,684 to *Lau et al.* (“*Lau*”).

These formal matters identified in the Office Action are addressed herein below.

AMENDMENTS TO SPECIFICATION

Amendments have been made to the first paragraph on page 9, the first and third paragraphs on page 11, and the last paragraph on page 12 of the specification. These amendments have been made to correct references to numbers in the drawings and to improve grammar and clarity in the specification. No new matter is believed to have been added by these amendments.

AMENDMENTS TO CLAIMS 2, 10, 15, AND 19

Minor amendments have been made to claims 2, 10, 15, and 19, to improve grammar, clarity, or claim form. Specifically, claims 2, 10, 15, and 19 were amended by changing the term “comprising” to “consisting of” with reference to a group. None of these amendments to the claims referred to in this section have been made in response to a substantive rejection or for any other purpose relating to patentability. The amendments made to the claims are believed to be

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fully supported by the present application as originally filed. Accordingly, no new matter has been added by these amendments.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Independent claims 1 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Washizu*. Claim 1 is directed to:

A CDMA receiver, comprising:
a first data path for correlating an incoming CDMA signal, located within a scanned signal window, with a locally generated signal;
a second data path for verifying the incoming CDMA signal, located within the scanned signal window, against a lock signal, the second data path determining whether the incoming CDMA signal has at least one characteristic which differentiates the incoming CDMA signal from an auto-correlated signal or a cross-correlated signal; and
means for inputting a second incoming CDMA signal to the first data path if the incoming CDMA signal lacks the at least one characteristic.

In general, *Washizu* fails to teach or disclose parallel data paths, *i.e.*, the first data path and the second data path, that allow standard correlation of signals in parallel with verification of a lock signal to determine whether an incoming CDMA signal has at least one characteristic that differentiates it from an auto-correlated or cross-correlated signal, *i.e.*, whether the system has locked onto the proper signal, within the scanned signal window. (page 5, lines 8-10.) *Washizu* also fails to teach continuing to search the scanned signal window for a second incoming CDMA signal if the incoming CDMA signal lacks the at least one characteristic.

In *Washizu*, a received GPS signal is amplified, converted into an intermediate-frequency ("IF") signal, and then correlated with a PN code generated by PN code generator. (Col. 4, lines 28-41.) *Washizu* further teaches, in FIG. 3, a switch 6 that selectively supplies an output signal

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from the PN code correlator 5 to either a signal search unit 7, a signal determining unit 8, or a signal tracking unit 9. (Col. 4, lines 42-45.) It is the Examiner's contention that the signal search unit 7 corresponds to the claimed first data path and the signal determining unit 8 the second data path.

When the power supply to the GPS signal receiver of *Washizu* is switched on, the switch 6 is shifted over to the signal search unit 7, which produces an output signal that enables the control circuit 11 to control the PN phase control unit 10 to successively vary the phase of the PN code generated by the PN code generator 4 until the correlated output signal exceeds a predetermined value. (Col. 5, lines 17-30.) The control circuit 11 then shifts the switch 6 over to the signal determining unit 8, and stores the correlated output signal in excess of the predetermined value into the first storage area of the RAM 81 of the signal determining unit 8. The control circuit 11 then shifts the switch 6 over to the signal search unit 7 again, and controls the PN code phase control unit 10 to control the PN code generator 4 to shift the phase of the PN code generated by the PN code generator 4 over a certain phase range into a previous phase. Then, when a second correlated output signal in excess of the predetermined value is found, this signal is stored in the second storage area of the RAM 81. (Col. 5, lines 31-47.)

A comparator 82 in the signal determining unit 8 is used to compare the correlated output signals stored in RAM 82, with the signal having the higher correlated signal peak determined as being produced by a direct wave. (Col. 6, lines 6-25.) Switch 6 is then switched over to the signal tracking unit 9 by an output signal from the control circuit 11. (Col. 6, lines 61-64.)

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First, *Washizu* does not teach, disclose, suggest or provide motivation for a first data path and a second data path as claimed in claim 1. Contrary to the Examiner's contention as to claim 1, the paths to the signal search unit 7 and the signal determining unit 8 do not correspond to the first and second data paths of claim 1. Because of the switch 6, FIG. 3, none of the data paths of *Washizu* operate in parallel, as is disclosed in the claimed invention. The first and second data paths disclosed in claim 1 each have their own path to their own CPU or other type of processor or may share the same CPU for processing. (Page 9, lines 1-6.) For this reason, the method of claim 1 does not require switching between various data paths.

Second, claim 1, in the second data path, determines "whether the incoming GPS signal has at least one characteristic that differentiates the incoming GPS signal from an auto-correlated signal or a cross-related signal, wherein the locally generated signal can change in order to continue to search the scanned signal window for a second incoming GPS signal if the incoming GPS signal lacks the at least one characteristic." (Emphasis added.) In contrast, the GPS signal receiver of *Washizu* uses only a PN code generated by a PN code generator that is phase controlled to search for a correlated output signal in excess of a predetermined value.

Therefore, *Washizu* fails to teach or describe all of Applicants' claim limitations in independent claim 1. Thus independent claim 1 is in condition for allowance. Claims 2-11 depend directly or indirectly from allowable claim 1, and therefore are distinguishable over *Washizu* for at least the same reasons.

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Furthermore, as for the Examiner rejecting claims 1, 2, 4-15, and 17-20 under 35 U.S.C. § 103(a), the Examiner acknowledges that “Washizu et al. does not expressly disclose correlating an incoming CDMA signal, located within a scanned signal window, with a locally generated signal on a first data path.” (Page 3, lines 15-17.) The Examiner also states that “one of average skill in the art would have recognized that the output signal from PN code correlator 5 is supplied to different paths.”

Given that *Washizu* does not disclose all of the elements of claims 1 and 12, the Examiner has failed to show that the required additional elements can be provided under 35 U.S.C. §103(a). First, the Examiner has failed to establish a *prima facie* case of obviousness as required by 35 U.S.C. §103(a), the applicable case law and MPEP §2142 because the Examiner has failed to show all of the following: 1) a motivation or suggestion to combine *Washizu* and the additional elements, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference (*i.e.*, *Washizu*) or to combine reference teachings; 2) a reasonable expectation of success; and 3) that *Washizu* and the additional elements when combined teach or suggest all of the claim limitations.

The MPEP § 2142 specifically states that the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” Additionally, MPEP § 2142 also states that the “initial burden is on the examiner to provide some suggestion of desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the

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references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Official notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. MPEP § 2144.03 A.

The USPTO cannot meet this requirement by simply stating that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine elements disclosed in other references with other elements well known in the art, viz:

The “common knowledge and common sense,” on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Act. The Board’s findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. ... “Common knowledge and common sense,” even if assumed to derive from the agency’s expertise, do not substitute for authority when the law requires authority. *In re Lee*, 277 F.3d 1338, 1344-1345, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Second, the fact that *Washizu* discloses an output signal from PN code correlator 5 being supplied to different paths is not the equivalent of teaching the parallel data paths, i.e., the first data path and the second data path, that allow standard correlation of signals in parallel with verification of a lock signal, of the present invention. The Examiner, therefore, has failed to describe all of the elements of claim 1 not disclosed in *Washizu* and further, has failed to show that there is any motivation or suggestion to combine *Washizu* and these additional elements in the knowledge generally available to one of ordinary skill in the art, or to modify the reference or

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to combine reference teachings; as well as a reasonable expectation of success; and that *Washizu* and the additional elements when combined teach or suggest all of the claim limitations.

Based on the foregoing, Applicants respectfully submit that Examiner's statements regarding the combination of *Washizu* and the other features known in the art are without foundation and do not support a *prima facie* conclusion of obviousness.

Independent claim 12 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Washizu*. Claim 12 is directed to a cellular telephone including a GPS receiver having the same features that distinguish claim 1 from *Washizu*. Claim 12 therefore is also allowable for the same reasons. Claims 13-20 depend or ultimately depend from claim 12, and therefore are distinguishable over the cited references at least for the same reasons.

In view of the foregoing, Applicants respectfully submit that claims 1-20 are patentable under 35 U.S.C. § 103(a) over *Washizu*, and respectfully request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn.

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CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Official Action.

Respectfully submitted,
Turetzky et al.

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